

REMARKS

In the Office Action mailed April 19, 2006, claims 1-4, 7-10 and 13-16 were rejected under 35 U.S.C. §103(a) over Shub et al. Reconsideration and withdrawal of these rejections are respectfully requested.

At the outset, kindly note that Shub et al. call for (see Fig. 1 and corresponding description):

- a **first** clearing house 104;
- a **second** clearing house 107;
- a **first** carrier 106, and
- a **second** carrier 109.

Here is Shub et al.'s method:

1. Customer gives merchant 193 the pair of numbers (c, t) and the identity of the payment agency 102 (See Col. 4, lines 25-28);
2. Merchant tells first clearing house 104 the numbers (c, t) (See Col. 4, lines 40-42);
3. Payment agency tells first clearing house 104 bank order numbers X1 and X2 (See Col. 4, lines 48-54);
4. First clearing house 104 transfers money to merchant and tells merchant to attach bank order number X1 to the package (See Col. 5, lines 11-21)
5. First clearing house 104 communicates the pair of bank order numbers X1 and X2 to the second clearing house 107 (See Col. 5, lines 21-22);
6. Merchant transfers package to first carrier 106 (See Col. 5, lines 22-28);
7. First carrier 106 delivers packages to the second clearing house 107 (See Col. 5, lines 30-31);
8. Second clearing house 107 replaces bank order number X1 with bank order number X2 and attaches X2 to package, obscuring X1 (See Col. 5, lines 32-34);
9. Second clearing house 107 transfers package to second carrier 109 (See Col. 48-50), and
10. Second carrier 109 contacts payment agency 102 to get the address corresponding to bank order number X2 and delivers the package to that address (See Col. 5, lines 60-61).

Note that **two** clearing houses are necessary, that **two** bank order numbers are necessary and that **two** carriers are necessary.

It is respectfully submitted that the Office is not free to mischaracterize and subvert the plain meaning of the reference in order to make a §103(a) rejection. Indeed, the Office has stated that “the Examiner interprets the first and second carrier to collectively be a “shipper”, shipping the package from the vendor to the customer.” Shub et al., however, cannot arbitrarily be interpreted to teach only a single carrier. Indeed, recall that two bank order numbers X1 and X2 are necessary in Shub et al. Shub et al. explicitly states that “**An essential part of the invention is that a clearinghouse replaces X1 with X2**” Col. 4, lines 57-58. This step is essential, because it is the bank order number X2 that is used by the **second** carrier to obtain the ultimate delivery address from the payment agency 102 (See step 10. above). The **first** carrier delivers the package from the merchant to the second clearing house 107 (Step 7 above) and the **second** carrier delivers the package (this time, labeled with bank order number X2) from the second clearing house 107 to the address given to it by the payment agency 102.

Turning now to the claims, independent claim 1 recites:

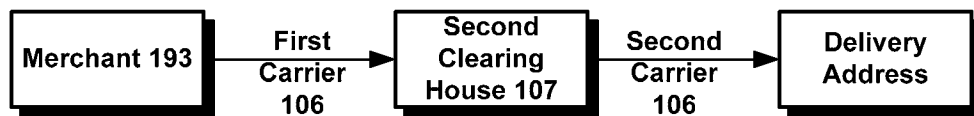
the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper

In Shub et al., the payment processor 102 does not send any shipping identifier or any address to the either the first or the second shipper, as required by the claim. See steps 6, 7 and 9, 10. In Shub et al., the second shipper contacts payment agency 102 to get the address corresponding to bank order number X2 and delivers the package to that address (See Col. 5, lines 60-61).

Claim 1 then continues:

...to enable the shipper, after picking up the package for shipment from the vendor, to associate the package code sent to the vendor with the shipping identifier, to identify the associated address as the delivery address of the package, and to ship the package directly from the vendor to the delivery address without divulging any delivery address for the package to the vendor.

Note that the claimed method enables the shipper to “ship the package “**directly** from the vendor to the delivery address.” In Shub et al., there is at least one intermediate destination (e.g., second clearing house 107) between the vendor and the delivery address of the package:



Shub et al., therefore, cannot be said to teach or to suggest the claimed method in which the shipper delivers the package directly from the merchant to the delivery address. In fact, it is abundantly clear that Shub et al. teach away from the claimed invention, because Shub et al. teach two shippers and two carriers and because Shub et al. are quite emphatic that the package is NOT directly delivered from the merchant to the delivery address, but instead teaches the use of an intermediate destination for the package (the second clearing house 107) between the merchant and the delivery address.

For the foregoing reasons, it cannot be said that Sub et al. teach or suggest the claimed invention. Reconsideration and withdrawal of the 35 U.S.C. §103(a) rejections applied to claim 1 and its dependent claims are, therefore, respectfully requested.

Independent claim 7 recites:

the shipper receiving a shipping identifier...

In Shub et al., the second carrier 106 does not receive a shipping identifier from anyone. Indeed, in Shub et al., the bank order number X2 is already affixed to the package, and the second carrier 106 then contacts the payment agency 102 to get the address corresponding to bank order number X2 and delivers the package to that address (See Col. 5, lines 60-61).

Independent claim 7 continues:

**the shipper matching the package code with the received shipping identifier,
and**

In Shub et al., the second shipper does not match any package code with a shipping identifier received from a bank, as required by the claim. Instead, Shub et al. teach for the second carrier to pick up the package (with bank order number X2 affixed thereto) and call the payment agency 102 to obtain the ultimate delivery address of the package, as noted in claim 10 above. Lastly, independent claim 7 recites:

**the shipper delivering the package from the vendor directly to the delivery
address associated with the shipping identifier.**

This is not the case in Shub et al., in which the package is first delivered to the second clearing house 107 before being delivered by the second carrier 106 to the customer's delivery address. There are no teachings or suggestions in Shub et al. that would lead a person of ordinary skill in this art to devise the claimed invention to directly deliver the package to the customer without resorting to multiple bank order numbers, clearing houses and two carriers. The person of ordinary skill in this art would be lead away from the claimed invention by Shub et al. There are no tenable arguments in which Shub et al. could be said to suggest the claimed invention in any way, for Shub et al. teach a method which is believed incompatible with the claimed embodiments. For the foregoing reasons, it cannot be said that Sub et al. teach or suggest the

claimed invention. Reconsideration and withdrawal of the 35 U.S.C. §103(a) rejections applied to claim 7 and its dependent claims are, therefore, respectfully requested.

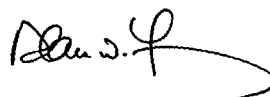
Claim 13 recites:

the vendor surrendering the package to a shipper to enable the shipper to match the package code with a shipping identifier and the delivery address that were previously received by the shipper from the bank, to generate a shipping label specifying the delivery address, to affix the shipping label to the package and to ship the package directly from the vendor to the delivery address without divulging any delivery address to the vendor.

Again, this claim recites that the package is directly delivered from the merchant to the customer without resorting to clearing houses, multiple shippers and multiple bank order numbers. The arguments advanced above relative to claims 1 and 7 are equally applicable here and are incorporated herein as if repeated in full. Reconsideration and withdrawal of the 35 U.S.C. §103(a) rejections applied to claim 13 and its dependent claims are, therefore, respectfully requested.

Applicant's attorney, therefore, respectfully submits that all remaining claims are allowable and, therefore, the present application is in condition for an early allowance and passage to issue. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below.

Respectfully submitted,



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By: _____

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